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No. 98-179

IN THE

Supreme Court of the United States

OCTOBER TERM, 1997

PANDUIT CORP.,

Petitioner,

v.

THOMAS & BETTS CORPORATION AND
THOMAS & BETTS HOLDINGS, INC.,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS FOR THE
SEVENTH CIRCUIT

REPLY BRIEF OF PETITIONER

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10 pp

RULE 29.6 LIST

Pursuant to Rule 29.6 of the Rules of this Court, petitioner states that it has no parent corporation and no nonwholly owned subsidiaries.

TABLE OF CONTENTS

RULE 29.6 LIST i

TABLE OF CONTENTS ii

TABLE OF AUTHORITIES iii

I. THE ISSUE PRESENTED IS AN IMPORTANT ONE THAT NEEDS TO BE RESOLVED BY THIS COURT 1

II. T&B HAS NOT UNDERMINED THE WORTHINESS OF PANDUIT'S PETITION 2

A. The Seventh Circuit's Decision Conflicts With *Singer* And *West Point* 2

B. This Case Is Ripe For Review 4

C. Panduit's Position Harmonizes The Patent And Trademark Laws 5

D. The Right To Copy Is Firmly Established 5

III. CONCLUSION 6

TABLE OF AUTHORITIES

Cases

Bonito Boats, Inc. v. Thunder Craft Boats, Inc.,
489 U.S. 141 (1989) 2, 4, 5

Compco Corp. v. Day-Brite Lighting, Inc.,
376 U.S. 234 (1964) 4

Esercizio v. Roberts,
944 F.2d 1235 (6th Cir. 1991) 3, 4

Gable v. Patton,
142 F.3d 940 (6th Cir. 1998) 3

Salmi v. Secretary of Health and Human Services,
774 F.2d 685 (6th Cir. 1985) 3

Sears, Roebuck & Co. v. Stiffel Co.,
376 U.S. 225 (1964) 4

Singer Mfg. Co. v. June Mfg. Co.,
163 U.S. 169 (1896) 2

West Point Mfg. Co. v. Detroit Stamping Co.,
222 F.2d 581 (6th Cir. 1955) 2, 3

Other Authorities

Geremia, Todd R., *Protecting The Right To Copy: Trade Dress Claims For Configurations In Expired Utility Patents*, 92 Nw. U. L. Rev. 779 (1998) 1

Hosteny, Joseph N., *Can A Trademark Be Used To Extend An Expired Patent?*
5 Intell. Prop. Today 40 (1998) 1

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Mohr, Kevin E., *At The Interface Of Patent And Trademark Law: Should A Product Configuration Disclosed In A Utility Patent Ever Qualify For Trade Dress Protection?*
19 Hastings Comm. & Ent. L.J. 339 (1997) 1

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I. THE ISSUE PRESENTED IS AN IMPORTANT ONE THAT NEEDS TO BE RESOLVED BY THIS COURT

Contrary to T&B's representations, the issue presented for review, under either party's formulation, cries out for this Court's attention now. In attempting to distance itself from its unqualified plea for Supreme Court review in 1996, T&B argues that things have changed since then, and that the need for Supreme Court intervention disappeared with the Seventh Circuit's decision in *T&B II*. Actually, the need has escalated. For example, just last month a prominent intellectual property litigator considered the *Vornado* and *T&B II* decisions and concluded that "[w]e therefore have two cases, with opposite results." Joseph N. Hosteny, *Can A Trademark Be Used To Extend An Expired Patent?* 5 Intell. Prop. Today 40, 41 (1998) (www.lawworks-iptoday.com).

Indeed, a common theme in many current law review articles is the growing conflict and uncertainty in this area, and it can only be resolved by this Court. Just a few examples, in addition to that cited in Panduit's petition (page 8), are: Todd R. Geremia, *Protecting The Right To Copy: Trade Dress Claims For Configurations In Expired Utility Patents,* 92 Nw. U. L. Rev. 779 (1998) (urging that anything less than a bright-line rule precluding trade dress protection for product configurations disclosed in expired utility patents contravenes Supreme Court precedent); Manotti L. Jenkins, *A Request To The High Court: Don't Let The Patent Laws Be Distracted By A Flashy Trade Dress,* 1 J. Marshall J. Computer & Info. L. 323 (1997) (maintaining that, in this modern era of society's continuing need for technological advancement, the patented product configuration issue is a societal interest equally important to issues recently considered by this Court and is in need of this Court's intervention); Kevin E. Mohr, *At The Interface Of Patent And Trademark Law: Should A Product Configuration Disclosed In A Utility Patent Ever Qualify For Trade Dress Protection?* 19 Hastings Comm. & Ent. L.J. 339

(1997) (noting that several lower court decisions demonstrate that the product configuration issue is becoming more common and that the courts are taking different approaches to resolving the issue).

The issue is also critically important to the business community, as Panduit explained in its petition (pages 21-22). The increasing availability of patents portends a flood of issues involving product configurations disclosed in expired patents, and manufacturers need to know what use they may make of expired patents. Is there truly a right to copy, as this Court has espoused from its decisions in *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896) to *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), or not?

II. T&B HAS NOT UNDERMINED THE WORTHINESS OF PANDUIT'S PETITION

The question for decision is whether Panduit has presented an issue worthy of consideration with the merits being left for later. However, following is a brief response to some of T&B's arguments that might appear to bear on the issue of the worthiness of Panduit's petition.

A. The Seventh Circuit's Decision Conflicts With *Singer* And *West Point*

The Seventh Circuit's decision in *T&B II* conflicts with this Court's decision in *Singer* and the Sixth Circuit's decision in *West Point Mfg. Co. v. Detroit Stamping Co.*, 222 F.2d 581 (6th Cir. 1955). Both *Singer* and *West Point* stand as good law and have not been qualified in any way.

In tacit recognition, T&B is left to argue that *Singer* is factually distinguishable. In doing so, it misstates Panduit's position (petition, pages 9-10) that *Singer* actually parallels the facts at bar. As is plain from the petition, Panduit does *not*, as T&B argues,

disagree with this Court's decision in *Singer*. This Court never said in *Singer* that the shapes of the Singer machines were dictated by the patents. Instead, that was the Seventh Circuit's interpretation. In disagreeing with that interpretation, Panduit relied on this Court's and the lower court's decisions in *Singer* to demonstrate conclusively that the Seventh Circuit's interpretation was wrong because both *Singer* decisions stated otherwise.

T&B tries to downplay the conflict with *West Point* by arguing that *West Point* turned on likelihood of confusion. The fallacy of this argument is explained in Panduit's petition (pages 12-13). At the same time, T&B completely ignores the Sixth Circuit's unequivocal holding that, upon expiration of a patent, a competitor may "manufacture and copy the article patented in which it was constructed during the existence of the patent . . . ." *West Point*, 222 F.2d at 588.

The Sixth Circuit's subsequent decision in *Esercizio v. Roberts*, 944 F.2d 1235 (6th Cir. 1991), did not upset the *West Point* holding, as T&B argues. Indeed, it could not have done so because *Esercizio* was not an *en banc* ruling. *Gable v. Patton*, 142 F.3d 940, 945 (6th Cir. 1998) ("'[A] panel of this Court cannot overrule the decision of another panel. The prior decision remains controlling authority unless an inconsistent decision of the United States Supreme Court requires modification of the decision or this Court sitting en banc overrules the prior decision.'") (quoting *Salmi v. Secretary of Health and Human Services*, 774 F.2d 685, 689 (6th Cir. 1985)).

In any event, *Esercizio* had nothing to do with the right to copy the disclosures of an expired utility patent. The issue of the interplay between patent and trademark protection for product configurations arose only because the defendant in that case argued that the plaintiff could not pursue its Lanham Act claim because it could have, but did not, pursue design patent protection for its product design. Notably, a strong dissent in *Esercizio* took

exception to the majority's holding which, in effect, gave the plaintiff "the equivalent of a design patent in perpetuity," in direct disregard of this Court's decisions in *Bonito Boats; Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964). *Esercizio*, 944 F.2d at 1252-53.

B. This Case Is Ripe For Review

This case is not only the right one for finally resolving the issue presented, but also, the case is ripe for such review. T&B's argument that the issue need not be resolved if Panduit eventually prevails on the secondary meaning, functionality, or likelihood of confusion issues misses the point that *all* of those issues are mooted if Panduit prevails on the issue now before the Court.

T&B further argues that the adequacy of Panduit's marking of its cable ties has not been conclusively resolved. Even so, the issue presented is ready for resolution because its outcome does not depend on the adequacy of the marking. The issue is the right to copy. Marking may or may not be a condition of that right, but is not determinative of the core issue.

Similarly, T&B argues that there is a fact issue as to whether or not its disclosure of the oval shape of its claimed head, the only shape for the head disclosed by T&B in its patent's drawings or written specification, was incidental. That, too, does not affect the ripeness of the issue presented because Panduit's position is that it had a right to copy the oval-shaped head because, incidental or not, it was the shape disclosed in T&B's patent and used by T&B in its commercial cable tie. Under *Singer* and *West Point*, that fact, and nothing more, is what gave Panduit the right to copy.

T&B's attempt to further complicate the issue by suggesting a hypothetical disclosure of a Mickey Mouse-shaped head or the T&B logo is likewise unavailing. The hypothetical is a red herring designed to provoke, but it has no bearing on the right to copy

under *Singer* and *West Point*. At most, T&B's hypothetical might be an interesting aside when the Court reaches the merits of the issue presented. It certainly does not constitute grounds for rejecting the petition.

C. Panduit's Position Harmonizes The Patent And Trademark Laws

Panduit's position creates harmony, not conflict, between the patent and trademark laws, as explained in Panduit's petition (pages 19-20). Thus, there was no tension requiring resolution by the Seventh Circuit, as T&B argues. Indeed, the Seventh Circuit's decision created a tension by extending trademark protection to a feature that is legally functional by virtue of its disclosure in an expired patent.

D. The Right To Copy Is Firmly Established

T&B's opposition brief overreaches and miscasts the record and the law on several points. But on *the* fundamental point, its position proves the need for this Court to grant the petition. T&B characterizes as "*questionable*" Panduit's premise that "the patent laws create an affirmative federal right to copy . . . ." (opposition, page 15, italics added). That T&B would take such a remarkable stance in light of this Court's teachings, at least as early as *Singer* and continuing to the present, undermines its entire opposition. In *Bonito Boats*, this Court could not have said it more strongly: "We have long held that after the expiration of a federal patent, the subject matter of the patent passes to the free use of the public as a matter of federal law." 489 U.S. at 152. If T&B seriously questions the right to copy the teachings of an expired patent, there is plainly a crying need for this Court to intervene.

III. CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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